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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,336	01/14/2004	Joseph G. Renter	K47.12-0001	3462
27367	7590	07/05/2006	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,336

Applicant(s)

RENTER, JOSEPH G.

Examiner

David C. Reese

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 11-13, 15-19 is/are rejected.
- 7) ☒ Claim(s) 3-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 6/7/2006.

- Claims 1 and 14 are canceled.
- Claims 2, 4, 8, 11, 12, 15, 16, and 18 were amended.
- Claims 2-13 and 15-19 are pending.

#### ***Claim Objections***

[1] Claim(s) 2, 4, 8, 11, and 12 were previously objected to because of informalities.

Applicant has successfully addressed these issues in the amendment filed on 6/7/2006.

Accordingly, the objection(s) to the claim(s) 2, 4, 8, 11, and 12 have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

[2] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 6/7/2006. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

#### ***Claim Rejections - 35 USC § 103***

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr., US- 3,443,398, in view of Pejchar, US-758,848, and further in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such

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that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 2, King, Jr. teaches of a conically-shaped stud mounting (10) extending conically outward from a conical point to form a conical basket (10) for securing a stone (12) therein, a post with a near end (14) attached to the conical point and a far end (14a), and a nut (20) engagable with the far end of the post (14a) for securing the stud mounting (10) to an ear (16);

a dangling element (32) for suspension below the stud mounting (10); and

an intermediary connecting member (26) having a center aperture (27) adapted to allow the post (14) to be inserted therethrough, wherein the intermediary connecting member (26) removably engages the conical basket (10).

The difference between the claim and King, Jr. is that the claim recites: wherein the stud mounting has at least two wires forming the conical basket; and that the center aperture of the intermediary connecting member (26) being of size to allow a portion of the conical basket (10) to also extend therethrough. First, Pejchar discloses an earring similar to that of King, Jr. In addition, Pejchar further teaches of the stud mounting having at least two wires forming the conical basket (c). It would have been obvious to one of ordinary skill in the art, having the disclosures of King, Jr. and Pejchar before him at the time the invention was made, to modify the basket (10) of King, Jr. to include at least two wires, as in Pejchar. One would have been motivated to make such a combination because first and foremost, King, Jr. in col. 4, beginning with lines 18 states, "It is apparent from the foregoing, then, that with a few conventional stud

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earring having different heads 12...the wearer can obtain a very large variety of earring designs and styles.” Pejchar, in turn, shows of such a “different head,” one of which is readily apparent to one skilled in the art of jewelry, as shown in Fig. 2. So thus, the exchange of conventional stud earring heads is purely a matter of art recognized equivalence.

Secondly, it would have been an obvious matter of design choice to increase the size of the center aperture of the intermediary connecting member [to allow] a portion of the conical basket to also extend therethrough, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. The statement above is underlined because it is pertinent to point out that the prior art device of King, Jr., would indeed not perform any differently than that of the instant invention. When in use, the intermediary connecting member of the prior art is structurally found between the conical basket and an ear of a user; keeping the dangle element in alignment with respect to the conical basket, emulating that of the instant invention. Further, there would be no

unexpected result (the later claimed inhibit rotation) to either the intermediary connecting member and/or the conical basket by increasing the size of the center aperture of said intermediary connecting member so as to allow the intermediary connecting member [to allow] a portion of the conical member therein.

Re: Claim 15, King, Jr. in view of Pejchar discloses wherein the intermediary connecting member (26) engages the wires (c of Pejchar) so as to inhibit rotation of the intermediary connecting member relative to the conical basket (10 in view of Pejchar) (the expected result if one were to increase the size of the center aperture of the intermediary connecting member, as shown by Pejchar inside d) (further, having the intermediary connecting member between the conical basket and the ear helps inhibit rotation of the intermediary connecting member relative to the conical basket).

[5] Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr., US-3,443,398, in view of Simpson, US-6,508,081.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 11, King, Jr. teaches of a jewelry design for adorning an ear, comprising:  
a stud mounting (10) having a stone (12), a post with a near end (14) and a far end (14a), and a nut (20) engageable with the far end of the post (14a) for securing the stud mounting (10) to an ear (16);

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a dangling element (32) having a wire attachment extending therefrom (34); and  
a removable intermediary connecting member (26) which removably, conformingly engages an exterior surface of the support wire (in view of below), and which includes a jump ring extending (28) outward therefrom for flexibly supporting the wire attachment (34) of the dangling element (32).

The difference between the claim and King, Jr. is that the claim recites: a bezel wire for securing the stone, and a support wire attached to the bezel wire. Simpson discloses an earring similar to that of King, Jr. In addition, Simpson further teaches of a bezel wire (8) for securing the stone (4), and a support wire (8') attached to the bezel wire (8) (Fig. 1). It would have been obvious to one of ordinary skill in the art, having the disclosures of King, Jr. and Simpson before him at the time the invention was made, to modify the basket (10) of King, Jr. to include both the bezel and support wires, as in Simpson. One would have been motivated to make such a combination because first and foremost, King, Jr. in col. 4, beginning with lines 18 states, "It is apparent from the foregoing, then, that with a few conventional stud earring having different heads 12...the wearer can obtain a very large variety of earring designs and styles." Simpson, in turn, shows of such a "different head," one of which is readily apparent to one skilled in the art of jewelry, as shown in his prior art figure, Fig. 1. So thus, the exchange of conventional stud earring heads is purely a matter of art recognized equivalence.

[6] Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr., US- 3,443,398, in view of Simpson, US-6,508,081.

As for Claim 12, King, Jr. teaches of a jewelry design for adorning an ear, comprising:

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a stud mounting (10) having a stone (12), a post with a near end (14) and a far end (14a), and a nut (20) engageable with the far end of the post (14a) for securing the stud mounting (10) to an ear (16);

a dangling element (32) having a wire attachment extending therefrom (34); and

a removable intermediary connecting member (26) which removably engages an exterior surface of the support wire (in view of below), and which includes a portion for flexibly supporting the wire attachment of the dangling element (28); and

wherein the intermediary connecting member (26) has a notch (27) formed therein at points where the intermediary connecting member (26) engages the support wire (in view of below).

The difference between the claim and King, Jr. is that the claim recites: a bezel wire for securing the stone, and a support wire attached to the bezel wire. Simpson discloses an earring similar to that of King, Jr. In addition, Simpson further teaches of a bezel wire (8) for securing the stone (4), and a support wire (8') attached to the bezel wire (8) (Fig. 1). It would have been obvious to one of ordinary skill in the art, having the disclosures of King, Jr. and Simpson before him at the time the invention was made, to modify the basket (10) of King, Jr. to include both the bezel and support wires, as in Simpson. One would have been motivated to make such a combination because first and foremost, King, Jr. in col. 4, beginning with lines 18 states, "It is apparent from the foregoing, then, that with a few conventional stud earring having different heads 12...the wearer can obtain a very large variety of earring designs and styles." Simpson, in turn, shows of such a "different head," one of which is readily apparent to one skilled in the art



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of jewelry, as shown in his prior art figure, Fig. 1. So thus, the exchange of conventional stud earring heads is purely a matter of art recognized equivalence.

Re: Claim 13, King, Jr. discloses wherein the intermediary connecting member (26) has a beveled area (inside 26) formed therein so that the intermediary connecting member (26) does not engage the stone (12) when the jewelry design is worn.

[7] Claims 16-19 is rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr., US- 3,443,398, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 16, King, Jr. teach of a jewelry design for adorning an ear (Fig. 2), comprising:

a dangling element (32 for suspension below the stud mounting (10); and

an intermediary connecting member (26) having a center aperture (27) adapted to allow a post (14) of the stud mounting (10) to be inserted therethrough, and wherein the intermediary connecting member (26) includes a portion (28, 34) for flexibly supporting the dangling element (32 of King Jr.).

The difference between the claim and King, Jr. is that the claim recites: the center aperture of the intermediary connecting member (26) being of size to allow a portion of the conical basket (10) to also extend therethrough. It would have been an obvious matter of design

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choice to increase the size of the center aperture of the intermediary connecting member [to allow] a portion of the conical basket to also extend therethrough, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. The statement above is underlined because it is pertinent to point out that the prior art device of King, Jr., would indeed not perform any differently than that of the instant invention. When in use, the intermediary connecting member of the prior art is structurally found between the conical basket and an ear of a user; keeping the dangle element in alignment with respect to the conical basket, emulating that of the instant invention.

Re: Claim 17, wherein the intermediary connecting member (26) has a notch (27) formed at a point where the intermediary connecting member (26) is adapted to engage a wire (14) forming the conical basket (10).

Re: Claim 18, wherein the intermediary connecting member (26) is adapted to engage the conical basket (10) so as to inhibit rotation of the intermediary connecting member relative to the

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conical basket (10) (having the intermediary connecting member between the conical basket and the ear helps inhibit rotation of the intermediary connecting member relative to the conical basket).

***Allowable Subject Matter***

[8] Claims 3-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As for Claims 4 and 8 (after fixing claim objections, see above), the prior art, incorporating other corresponding limitations as set forth above, does not teach of the specific structure of intermediary connecting member possessing a number of legs and notches forming various shapes, respective to that of the number of wires forming the conical basket of the stud mounting of the instant invention, allowing said legs and notches to then engage a respective one of the said wires forming the conical basket. Claims 3, 5-7; and 9-10 are allowable since they are dependent upon independent claims 4 and 8.

***Response to Arguments***

[9] Applicant's arguments filed 6/7/2006 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. The applicant's instant amendment primarily to claims 15 and 18 solely add functional language to the instant claims by stating that the intermediary connecting member engages the wires [so as to inhibit rotation of the intermediary connecting member relative to the conical basket]. The former limitation adds no structural limitation to the instant claim, and only requires that the prior art device be capable of such a function, that is, of inhibiting rotation (to any degree) between the intermediary connecting

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member relative to the conical basket. Consequently, when the prior art device of King Jr., in view of Pejchar is in use, it is apparent that having the intermediary connecting member between the conical basket and one's ear does, by its very nature of its instant structure, help inhibit rotation of the intermediary connecting member relative to the conical basket due to the friction and/or force being maintained by the ear in the back and the stud in the front. Thus, the prior art of King Jr., in view of Pejchar does indeed satisfy the limitation of being capable of inhibiting rotation of the intermediary connecting member relative to the conical basket.

Further, with respect to the argument regarding a mere change in the size of a component, wherein a device having the claimed relative dimensions would not perform differently than the prior art device it is important to point out that this incorporates combinations that include situations where the change in size performs no unexpected result, in this case, to either the intermediary connecting member and/or the conical basket by increasing the size of the center aperture of said intermediary connecting member so as to allow the intermediary connecting member [to allow] a portion of the conical member therein. It is readily apparent and appreciated in the art of jewelry of the change of sizes of components and the expected results due to said changes. The argument that a device performs differently and the former is not due to merely a change in relative dimensions is only persuasive when the result is one of an unexpected nature. King, Jr., shows an intermediary member with a hole smaller than that of the intermediary connecting member hole from Pejchar. The difference, therefore, between the relationship of the intermediary member to the conical basket is thereby an obvious one, one that is shown between the two prior art. As stated, the hole in the intermediary connecting member of Pejchar is indeed bigger thereby allowing the intermediary connecting member to engage

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more of the conical basket than that of King, Jr., since King, Jr., shows of a hole in the intermediary member that is smaller. This is an example of why such is not considered an unexpected result, thereby rendering a change of mere size of a device to one skilled in the art of jewelry as obvious. This is valid in the instant case because the relationship between the intermediary connecting member, the conical basket, and the resulting inhibition of rotation is one purely of a functional nature. There is currently no structural limitation to the claims properly describing the structural nature of the above relationship allowing for such an inhibition of rotation.

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**Conclusion**

**[10] THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**[11]** Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR

  
6/13/06

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